

REMARKS

This is a response to the Office Action dated October 13, 1995. Claims 1-7, 9-10, 12, 15, 18-19 and 29-32 are pending in this application. In the Office Action, the Examiner has 1) rejected Claims 1, 2, 12 and 15 under 35 U.S.C. 112 and 2) provisionally rejected Claims 1-7, 9-10, 12, 15, 18-19 and 29-32 under the judicially created doctrine of obviousness-type double patenting.

In this response, Applicants request reconsideration of the rejections.

SECTION 112 REJECTION

The Examiner has objected to the specification and rejected Claims 1, 2, 12 and 15 under 35 U.S.C. 112.

A. The Examiner states that the provisos in Claim 1 are not clear. In an effort to clarify the claim, Claim 1 has been divided into two parts. First, Applicants have amended Claim 1 herein to encompass those compounds wherein X is H and Y is OH, eliminating the need for the proviso. Secondly, Applicants have added by amendment herein new Claims 33-34 to encompass those compounds of original Claim 1 wherein X is OH and Y is H.

B. The Examiner states that the term "N-protecting group is beyond enablement. Applicants assert the term "N-protecting" group is fully and clearly defined and enabled by the specification (see page 11). In an effort to advance the prosecution of this application, Applicants have amended Claim 1 herein to include the definition of "N-protecting group" as found on page 11 of the specification.

C. The Examiner states that Claims 12 and 15 are beyond enablement since the scope of the claims is much more than that of Claim 29, for which Applicants have provided evidence of in vivo testing.

Applicants assert that Claims 12 and 15 are dependent on Claim 29 and, therefore, Claims 12 and 15 are of the same scope as Claim 29. The Examiner is respectfully directed to Applicants' amendment dated March 2, 1995, in which Claims 12 and 15 were amended to depend from Claim 29, the compound for which in vivo test results have been provided.

In view of all of the above, Applicants respectfully request that the Examiner reconsider and withdraw the Section 112 rejection.

PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

The Examiner has provisionally rejected Claims 1-7, 9-10, 12, 15, 18-19 and 29-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending applications Serial No. 08/288,857, Serial No. 08/185,666, Serial No. 08/420,174, Serial No. 08/455,458, Serial No. 08/455,922 and Serial No. 08/455,052.

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Applicants assert that, other than Serial No. 08/420,174, the cited applications have no direct relationship to the present application. Furthermore, the subject matter of the claims of the cited applications is distinct from the subject matter of the claims of the present application.

Applicants assert that the invention claimed in Serial No. 08/288,857 (U.S. 5445191), i.e., high pressure brake hose, has no relationship at all to the subject matter claimed in the present application.

The compounds claimed in Serial No. 08/185,666, Serial No. 08/455,458, Serial No. 08/455,922 and Serial No. 08/455,052 , while structurally related to one another, are structurally very different from the compounds claimed in the present application and neither group of compounds can be considered obvious in view of the other.

Lastly, the compounds claimed in Serial No. 08/420,174 (which is a division of the parent of the present application) are prodrugs or esters of the compounds claimed in the present application. Should claims be found allowable in Serial No. 08/420,174, Applicants will consider filing a terminal disclaimer in Serial No. 08/420,174 relative to the patent resulting from the present application.

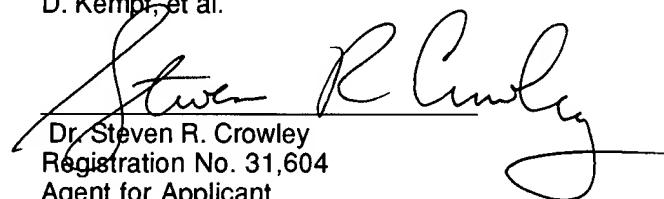
In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the provisional rejection.

ACTION REQUESTED

In view of all of the above, reconsideration and allowance of Claims 1-7, 9-10, 12, 15, 18-19 and 29-32 (as amended) and Claims 33-34 (newly added) is respectfully requested.

Respectfully submitted,

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